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10/773,279	02/09/2004	Shin Nakashima	2003-1778A	8573

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EXAMINER
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DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/773,279

Applicant(s)

NAKASHIMA, SHIN

Examiner

Tamra L. Dicus

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Claims 1-2 recite the limitation “the cob”. There is insufficient antecedent basis for this limitation in the claim. Further, the instant specification provides no clear definition of the meaning of this term (see page 2, paragraph 4 and page 3, lines 21-23). Further, on page 3 of the instant specification, the term appears to be related to a Japanese Standard. Applicant is advised to provide an English translation or standard as it is a foreign standard.
3. Further, to claim “outdoor advertisements, outdoor notifications, etc” is ambiguous because et cetera can mean an uncertain variety of more than what is claimed.
4. Claim 2, line 5 states “a layer of adhesives”, which is unclear. Is this a plurality of adhesive layers or does the layer comprise more than one adhesive?

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,028,028 to Nitta.

Regarding claim 1, Nita teaches a perfectly waterproofed printing and copying sheet suitable for outdoor advertisements and notifications (Abstract, col. 3, lines 5-18 and col. 4, lines 13-15), comprising a sheet of colored opaque paper (col. 4, line 52, col. 5, line 13, col. 7, lines 27-45, col. 8, lines 10-16 and col. 12, lines 62-68; (A'), FIG. 1 and associated text), a colorless transparent film of water-resisting heat-resisting synthetic resin of PET (polyethylene terephthalate) or PC (polycarbonate) which is dry-laminated on the front surface of the sheet of paper (col. 5, lines 42-62; (B), FIG. 1 and associated text, same PET as in Applicant's specification at page 5, line 1), a colorless transparent thin film of water-resisting heat-resisting synthetic resin of a transparent thermoplastic resin such as PET which is dry-laminated on the back surface of the sheet of paper (col. 6, lines 5-8, col. 6, line 47- col. 7, line 15). See also.

Nitta does not expressly define the sheet of claim 1 having water absorbing capacity of the cob of less 30 g/m<sup>2</sup>, however, this would be an obvious expectation as the same materials and structure is provided.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,028,028 to Nitta in view of USPN 6,235,363 to Bilodeau.

Regarding claim 2, Nita teaches a perfectly waterproofed printing and copying sheet suitable for outdoor advertisements and notifications (Abstract, col. 3, lines 5-18 and col. 4, lines 13-15), comprising a sheet of colored opaque paper (col. 4, line 52, col. 5, line 13, col. 7, lines

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27-45, col. 8, lines 10-16 and col. 12, lines 62-68; (A'), FIG. 1 and associated text), a colorless transparent film of water-resisting heat-resisting synthetic resin of PET (polyethylene terephthalate) or PC (polycarbonate) which is dry-laminated on the front surface of the sheet of paper (col. 5, lines 42-62; (B), FIG. 1 and associated text, same PET as in Applicant's specification at page 5, line 1), a layer of adhesives on the back surface of the sheet of paper (A') at col. 7, line 50-col. 8, lines 10-16. See also col. 12, lines 62-68).

Nitta does not expressly define the sheet of claim 2 having water absorbing capacity of the cob of less 30 g/m<sup>2</sup>, however, this would be an obvious expectation as the same materials and structure is provided.

Nitta does not teach a releasing paper releasably affixed to the surface of the layer of adhesives.

Bilodeau teaches a release paper liner (50, FIG. 1 and associated text) releasably affixed to the surface of heat-activatable acrylic rubber based adhesive (30, FIG. 1 and associated text; col. 4, lines 20-35) and paper (20, FIG. 1 and associated text) for signs in order to use laminated constructions as labels to secure to any substrate (Abstract, col. 1, lines 1-40, col. 2, lines 10-30, col. 11, lines 24-30).

It would have been obvious to one having ordinary skill in the art to have modified the sheet of Nitta to further include a release paper affixed to the adhesive layer because Bilodeau teaches adding a release paper assists in transfer to any substrate (FIG. 1 and associated text, Abstract, col. 1, lines 1-40, col. 2, lines 10-30, col. 11, lines 24-30 of Bilodeau).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,028,028 to Nitta in view of USPN 6,503,620 to Xie et al.

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Because the claim is not clear as to how many adhesives are included, Nitta in view of Xie is used to show two layers of adhesives are included.

Regarding claim 2, Nita teaches a perfectly waterproofed printing and copying sheet suitable for outdoor advertisements and notifications (Abstract, col. 3, lines 5-18 and col. 4, lines 13-15), comprising a sheet of colored opaque paper (col. 4, line 52, col. 5, line 13, col. 7, lines 27-45, col. 8, lines 10-16 and col. 12, lines 62-68; (A'), FIG. 1 and associated text), a colorless transparent film of water-resisting heat-resisting synthetic resin of PET (polyethylene terephthalate) or PC (polycarbonate) which is dry-laminated on the front surface of the sheet of paper (col. 5, lines 42-62; (B), FIG. 1 and associated text, same PET as in Applicant's specification at page 5, line 1), a layer of adhesives on the back surface of the sheet of paper (A') at col. 7, line 50-col. 8, lines 10-16. See also col. 12, lines 62-68).

Nitta does not expressly define the sheet of claim 2 having water absorbing capacity of the cob of less 30 g/m<sup>2</sup>, however, this would be an obvious expectation as the same materials and structure is provided.

Nitta does not teach a releasing paper releasably affixed to the surface of the layer of adhesives (interpreting as more than one layer of adhesive).

Xie teaches a multilayer composite showing a facestock (42, FIG. 4 and associated text) having two layers of hot melt adhesives (44 and 48, FIG. 4 and associated text; col. 8, lines 15-20) releasably adhered to release paper liner (48, FIG. 4 and associated text) for further improving the adhesion of the facestock and using the release liner for use in die-cut labels. See also col. 3, lines 1-11.

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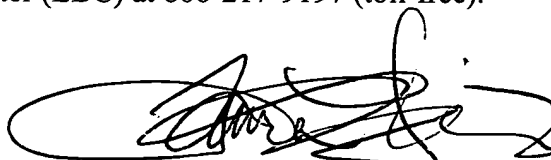
It would have been obvious to one having ordinary skill in the art to have modified the sheet of Nitta to further include a release paper affixed to the layer of adhesives because Xie teaches two layers of adhesive are employed for further improving the adhesion of the facestock and employs the release liner for use in die-cut labels (FIG. 4 and associated text and col. 3, lines 1-11 of Xie).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus  
Examiner  
Art Unit 1774

September 19, 2005



RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U. 1774 9/22/05